Remarks

This REPLY is in response to an Office Action mailed January 27, 2006.

Applicants acknowledge withdrawal of claims 4, 8, 12-18, 21 and 22 without prejudice. Applicants reserve the right to prosecute those claims in continuing applications.

Prior to this Office Action, claims 1-3, 5-7, 9-11, 19, 20 and 23-26 are pending and are rejected.

Priority

The Examiner has refused the claim of priority to NZ 520,866 and NZ 508,779 because no Certified Copies were provided. Applicants note that the priority PCT application claimed priority to NZ 508,779, and therefore, no Certified copy of the NZ provisional application is required. Applicants have been attempting to obtain a Certified Copy of NZ 520,866, and will submit it when it is received. The Examiner's patience is greatly appreciated.

The Examiner has refused the claim of priority to US 10/450,232, claiming that the '232 application "is not a prior filed Application." Office Action, page 2.

According to 35 U.S.C. §363, "An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title." (2006).

The '232 application was a 371 of PCT International Application PCT/NZ01/00277, filed December 11, 2001, which claimed priority to NZ 508,779, filed December 11, 2000. Thus, under 35 U.S.C. §363, the '232 application has an effective filing date of the December 11, 2001, which was before the filing of the instant application on August 19, 2003. Therefore, Applicants respectfully submit that the priority claim of the instant application to the prior applications as amended is proper.

Objection to Claims

Claim 1 was objected to for an inconsistency between the preamble and the result. Applicant has amended the preamble of claim 1 to be consistent with the result.

Rejection of Claims

Claims 24-26 stand rejected under 35 U.S.C.§112, second paragraph as indefinite. Claim 24 has been amended to delete the references to "LR3IGF-1" and "Long™R3IGF-1." and believes these claims are not indefinite.

1. Anticipation Under 25 U.S.C. §102

Rejections Over Vickers

Claims 1-3, 5-7, 9-11, 23, 25 and 26 stand rejected under 35 U.S.C. §102(b) as anticipated by Vickers et al (NZ 508,779).

Applicants have amended the priority claim to point out specifically the proper chain of priority in paragraph [0001], reproduced below for convenience.

> This application is a Continuation-in-Part of U.S. application Ser. No: 10/450,232, which is a 371 of PCT/NZ01/00277, filed December 11, 2001, which claims priority to NZ 508,779, filed December 10, 2000. This application also ~~and~~ claims priority to New Zealand Provisional Patent Specification Serial No: 520,886, filed Aug. 19, 2002.

Applicants respectfully submit that this application claims priority to NZ 508,779, which is therefore not prior art. Therefore, Applicants submit that this rejection is now moot.

Rejections Over Ikenasio

Claims 1-3, 6, 7, 9, 11 and 23 stand rejected under 35 U.S.C. §102(b) as anticipated by Ikenasio et al. (Vickers, et al. Endocrinology (2001) 142(9), pages 3964-3973).

As noted above, Applicants have amended the claim for priority to include NZ 508,779, which was filed prior to the publication of the above Endocrinology article. Therefore, Ikenasio is not prior art to the claims in this application and this rejection is now moot.

Rejections Over Clark

Claims 1-3, 5-7, 9-11, 19, 20, 23, 25 and 26 stand rejected under 35 U.S.C. §102(b) as anticipated by Clark (US Patent No: 5,565,428; "Clark").

Applicants have amended claim 1 to include the limitation "mammal subject to fetal programming, having a history of: at least one of low birth weight, maternal undernutrition and interuterine undernutrition..."

Applicants can find no disclosure in Clark of treating any mammal having "fetal programming." Therefore, Applicants submit that Clark cannot anticipate amended claim 1 or any claim dependent from claim 1. Because each of the claims subject to this rejection depend ultimately from claim, Applicants submit that none of the claims are anticipated by Clark.

Rejections Over Gluckman

Claims 1-3, 5-7, 9-11, 23, 25 and 26 stand rejected under 35 U.S.C. §102(b) as anticipated by Gluckman (US Patent No: 5,922,673; "Gluckman").

Applicants have amended claim 1 to include the limitation "mammal subject to fetal programming, having a history of: at least one of low birth weight, maternal undernutrition and interuterine undernutrition..."

Applicants can find no disclosure in Gluckman of treating any mammal having "fetal programming." Therefore, Applicants submit that Gluckman cannot anticipate amended claim 1 or any claim dependent from claim 1. Because each of the claims subject to this rejection depend ultimately from claim, Applicants submit that none of the claims are anticipated by Gluckman.

Rejections Over Williams

Claims 1, 3, 6, 7, 9-11, 23, 25 and 24 stand rejected under 35 U.S.C. §102(b) as anticipated by Williams (WO 95/17204 A1; "Williams").

Applicants have amended claim 1 to include the limitation "mammal subject to fetal programming, having a history of: at least one of low birth weight, maternal undernutrition and interuterine undernutrition..."

Applicants can find no disclosure in Williams of treating any mammal having "fetal programming." Therefore, Applicants submit that Williams cannot anticipate amended claim 1 or any claim dependent from

claim 1. Because each of the claims subject to this rejection depend ultimately from claim, Applicants submit that none of the claims are anticipated by Williams.

2. Obvious Under 35 U.S.C. §103

Claims 1-3, 5-7, 9-11, 19, 20, and 23-26 stand rejected under 35 U.S.C. §103(a) as obvious over combinations of Gluckman, Clark, Williams, DiMarchi (US Patent No: 5,622,932; "DiMarchi") and Ambler (US Patent No: 5,420,111; "Ambler").

As noted above, none of Gluckman, Clark, Williams teaches or suggests any therapy using IGF-1 compounds to treat a "mammal subject to fetal programming, having a history of: at least one of low birth weight, maternal undernutrition and interuterine undernutrition" as in Applicant's amended claim 1.

Similarly, Applicant can find no teaching or suggestion in DiMarchi or in Ambler of any use of IGF-1 compounds to treat a "mammal subject to fetal programming, having a history of: at least one of low birth weight, maternal undernutrition and interuterine undernutrition" as in Applicant's amended claim 1.

Because none of the references teach or suggest such a use of an IGF-1 compound, no combination of the references teach or suggest all of the limitations of Applicant's claim 1. Applicants therefore respectfully submit that no combination of the above references could render claim 1 or any claim depending from claim 1 obvious to a person of ordinary skill in the art with a reasonable likelihood of success and without undue experimentation.

Conclusion

Applicants respectfully submit that none of the claims currently pending are either indefinite, anticipated or rendered obvious under any of the rationales set forth in the Office Action.

Applicants believe that all the claims in this case are allowable, and urge the Examiner to consider the patentability of the claims and find the claims allowable.

Included with this Response is a Petition for Extension of time for three (3) months.

If the Examiner believes that a conversation with the undersigned would move this application forward, the undersigned Attorney invites such a conversation.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: July 19, 2006

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